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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,438	09/28/2000	Todd O. Burger	C1068/7005	9912

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,438

Applicant(s)

BURGER ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 138, 140, 141, 144-146, 148, 149, 152, 153, 155, 156, 159, 160, 162, 163, 168-177 and 180 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 138,140,141,144-146,148,149,152,153,155,156,159,160,162,163,168-177 and 180.

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 01 November 2004.
2. Claims 138, 140, 145, 146, 148, 153, 155, 160, 162, 168-176 have been amended.
3. Claim 180 is new.
4. Claims 139, 142, 143, 147, 150, 151, 154, 157, 158, 161, 164-167, 178, and 179 have been cancelled.
5. Claims 138, 140, 141, 144-146, 148, 149, 152, 153, 155, 156, 159, 160, 162, 163, 168-177 and 180 are pending and have been examined.

RESPONSE TO ARGUMENTS

6. Applicant has not presented any arguments.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 138, 140, 141, 144, 145, 146, 148, 149, 152, 153, 155, 156, 159, 160, 162, 163, 168, 169, 170, 172, 174, 176, and 180 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin et al. (US 4,868,376 A) in view of Gatto (US 5,546,523 A), and further in view of Angelo et al. (US 6,182,892 B1).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 138, 146, 153, 160, 168, 169, 170, 172, 174, and 176:

Lessin, in at least column 1, line 1 to column 2, line 10, discloses a smart card and smart card transactions to include authentication, identification, inherent communications between the smart card, POS terminal, and associated server infrastructure, and updating the smart card after routine transactions, essentially disclosing:

- (B) establishing a communication link between a controller associated with the database and a portable electronic device distinct and remotely located from the database, and transferring at least the first account information and the second account information from the database to a memory of the portable electronic device via the communication link so that at least the first account information and the second account information are caused to exist simultaneously in the memory of the portable electronic device;*
- (C) transporting the portable electronic device to a vicinity of a first point-of-sale (POS) terminal;*

(D) when the portable electronic device is in the vicinity of the first POS terminal, manipulating a user input of the portable electronic device to select the first media for use in a first transaction at the first POS terminal;

(F) transporting the portable electronic device to a vicinity of a second POS terminal;

(G) when the portable electronic device is in the vicinity of the second POS terminal, manipulating the user input on the portable electronic device to select the second media for use in a second transaction at the second POS terminal; and

(H) releasing at least a portion of the second account information from the portable electronic device to the second POS terminal so as to authorize the second transaction.

Lessin does not specifically disclose *(A) storing at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer in a database so that the first account information and the second account information exist simultaneously in the database.* Gatto, however, in at least column 11, lines 24-25 and line 54 discloses a smart card that contains multiple accounts. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin with Gatto because multiple accounts on one card increases user efficiency.

The combination of Lessin/Gatto discloses the system as shown above. Lessin/Gatto do not disclose:

(E1) causing a token attached to the portable electronic device to embody at least a portion of the first account information:

(E2) after performing the step (E1), detaching the token from the portable electronic device with the token continuing to embody at least the portion of the first account information after the token has been detached from the portable electronic device;

(E3) after performing the step (E2) and when the token is still detached from the portable electronic device interfacing the token with the first POS terminal and transferring at least the portion of the first account information from the token to the first POS terminal;

(E4) after performing the step (E3), re-attaching the token to the portable electronic device;
(H1) causing the token to embody at least a portion of the second account information
(H2) after performing the step (H1), detaching the token from the portable electronic device,
with the token continuing to embody at least the portion of the second account information
after the token has been detached from the portable electronic device;
(H3) after performing the step (H2), and when the token is still detached from the
information after the token has been detached from the portable electronic device,
interfacing the token with the second POS terminal and transferring at least the portion of
the second account information from the token to the second POS terminal, and
(H4) after performing the step (H3) re-attaching the token to the portable electronic
device.

Angelo, however, in at least column 1, lines 42-56 discloses detachable and therefore releasable attachments, as well as inherently disclosing magnetic stripe readers essential to POS machines. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin/Gatto with Angelo because a releasable attachment provides flexibility of use.

Claims 140, 141, 148, 149, 155, 156, 162, and 163:

With regard to the limitations of:

- *employing a user-authenticator included in the first portable electronic device to authenticate an identity of a user of the first portable electronic device; and*
- *enabling each of the steps (E2) and (H2) to be performed only after the user authenticator has authenticated the identity of the user;*
- *measuring a biometric characteristic of the user of the portable electronic device;*
and

- *comparing the measured biometric characteristic with a representation of a biometric characteristic stored in memory of the portable electronic device.*

Lessin, in at least column 4, line 10, discloses the use of biometric identifiers.

Claims 144, 152, 159, and 180:

The combination of Lessin/Gatto discloses the limitations as shown above. Lessin/Gatto do not specifically disclose *the first and second media issuers are unrelated*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate multiple accounts on one smart card that were not affiliated with each other, such as, for example VISA® and MASTERCARD® because multiple accounts on one card increases user efficiency.

Claim 145:

With regard to the limitations of:

(I) storing at least third account information for a third media issued by a third media issuer and fourth account information for a fourth media issued by a fourth media issuer in the database so that the first account information, second account information, third account information, and fourth account information exist simultaneously in the database;

(J) establishing a second communication link between the controller associated with the database and a second portable electronic device distinct and remotely located from the database, and transferring at least the third account information and the fourth account information from the database to a memory of the second portable electronic device via the communication link so that at least the third account information and the fourth account information are caused to exist simultaneously in the memory of the second portable electronic device;

(K) transporting the second portable electronic device to a vicinity of a third point-of-sale (POS) terminal;

(L) when the second portable electronic device is in the vicinity of the third POS terminal, manipulating a user input of the second portable electronic device to select the third media for use in a third transaction at the third POS terminal;

(M1) causing a second token attached to the second portable electronic device to embody at least a portion of the third account information:

(M2) after performing the step (M1) detaching the second token from the second portable electronic device with the second token continuing to embody at least the portion of the third account information after the second token has been detached from the second portable electronic device

(M3) after performing the step (M2) and when the second token is still detached from the second portable electronic device interfacing the second token with the third POS terminal and transferring at least the portion of the third account information from the second token to the third POS terminal:

(M4) after performing the step (M3) re-attaching the second token to the second portable electronic device:

(N) transporting the second portable electronic device to a vicinity of a fourth POS terminal;

(O) when the second portable electronic device is in the vicinity of the fourth POS terminal, manipulating the user input on the second portable electronic device to select the fourth media for use in a fourth transaction at the fourth POS terminal;

(PI) causing the second token to embody at least a portion of the fourth account information;

(P2) after performing the step (PI), detaching the second token from the second portable electronic device with the second token continuing to embody at least the

portion of the fourth account information after the second token has been detached from the second portable electronic device;

(P3) after performing the step (P2) and when the second token is still detached from the second portable electronic device interfacing the second token with the fourth POS terminal and transferring at least the portion of the fourth account information from the second token to the fourth POS terminal; and

(P4) after performing the step (P3) re-attaching the second token to the second portable electronic device.

See the rejection of claims 138, 146, 153, 160, 168, and 169 as shown above. It would have been obvious to one of ordinary skill in the art at the time of the invention to include third and fourth accounts because multiple accounts on one card increases user efficiency.

9. Claims 171, 173, 175, and 177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin/Gatto/Angelo in view of Postlewaite et al. (US 5,854,891 A).

Claims 171, 173, 175, and 177:

The combination of Lessin/Gatto/Angelo discloses the limitations as shown above. Lessin/Gatto/Angelo do not specifically disclose *causing a simulated magnetic stripe to be generated on the token*. Postlewaite, however, in at least column 2, lines 20-56 discloses virtual smart cards. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin/Gatto/Angelo with Postlewaite because a virtual smart card system enables computer users to use multiple smart cards during the normal operation of their computer without inserting a plurality of physical smart cards into a smart card reader (Postlewaite, column 2, lines 20-23).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

08 March 2005

